

REMARKS/ARGUMENTS

In the Office Action dated November 15, 2004, the Examiner objected to the specification under 35 U.S.C. § 112, first paragraph as not being written using "full, clear, concise, and exact terms." The Examiner then objected to claims 1-8 because of informalities wherein the Examiner stated that "each claim includes the limitation '... separation medium composed of a plurality of separation media ...' which is confusing because it defines a singular medium as including plural media." Next, the Examiner rejected claims 1-8 under 35 U.S.C. § 102(e) as being anticipated by Anderson, et al. and Wiktorowicz, et al. Finally, the Examiner rejected claims 1-8 under 35 U.S.C. § 102(b) as being anticipated by Ledley.

The applicants have carefully reviewed the Examiner's rejections and objections, the reasons therefore, and the prior art cited. In response, the Applicant had made various amendments to the specification to address the 35 U.S.C. § 112 objections and has made various amendments to the claims to further define the claims over the prior art to eliminate the 35 U.S.C. § 102 (b) and (e) rejections.

The specification has been amended to correct numerous grammatical errors resulting from the translation into the English language and thus a substitute specification is being filed concurrently herewith. Also filed concurrently herewith is a marked-up version of the specification with markings to show all of the changes. The substitute specification includes no new matter.

Claims 2 and 7 have been cancelled without prejudice and claims 1, 3-6, and 8 have been amended to better claim the invention. New claim 9 further defines the first dimensional separation technique. The language of the amended claims as well as new claim 9 is supported by the as-filed claims and disclosure, as will be discussed in further detail below. None of the amendments set forth herein constitute the addition of new matter.

Support for the concept as a whole may be found in the disclosure as originally filed on page 13, line 10 to page 14, line 9. Support for the term "sample" and "test sample" in claims 1, 5 and 8 may be found on page 15, lines 25-27; page 16, lines 9-11; page 16, lines 15-

16; page 16, line 20; page 19, line 29; page 21, lines 8-10; page 23, line 22 to page 24, line 1; page 24, lines 8-9; and page 24, lines 25-26 in the disclosure as originally filed. Support for the term "first dimensional separation", "two dimensional separation" and "two-dimensionally separating" in claims 1, 4-6, 8 and 9 can be found throughout the specification as originally filed. Support for the term "electrophoresis" in claims 1, 5 and 8 can also be found throughout the specification as originally filed. Support for the term "isoelectric focusing" in claims 1, 4-6, 8 and 9 may be found on page 10, lines 5-7; page 14, lines 16-20; page 16, lines 11-13; page 16, lines 21-22; page 20, lines 32-34; page 21, lines 10-12; page 23, lines 20-26; and page 24, lines 17-20 in the disclosure as originally filed. Support for the term "capillary electrophoresis" in claims 1, 5 and 8 may be found on page 12, line 5-10; page 13, line 10 to page 14, line 9; page 15, lines 19-20; page 15, lines 25-26; page 16, line 15; and page 25, lines 19-21 in the disclosure as originally filed. Support for the term "planar support" in claims 1, 5 and 8 may be found on page 6, line 28; page 7, line 9; and page 11, line 11 in the disclosure as originally filed. Support for the term "gel" in claims 1, 5 and 8 may be found on page 1, lines 18-19; page 3, line 36; page 4, line 18; page 10, lines 7-9; page 10, lines 32-35; page 16, lines 25-26; page 22, line 6; page 23, lines 21-25; and page 24, lines 18-29 in the disclosure as originally filed.

The Rejection under 35 U.S.C. § 112, First Paragraph

The specification has been objected to as failing to be written in "full, clear, concise, and exact terms." The examiner found the specification to be replete with terms that are not clear, concise and exact and requested that the specification be revised carefully in order to comply with 35 U.S.C. § 112, first paragraph. The Applicant has made numerous corrections to correct grammatical errors resulting from the translation into the English language and thus a substitute specification is being filed concurrently herewith. Also filed concurrently herewith is a marked-up version of the specification with markings to show all of the changes. The substitute specification includes no new matter.

The amendments to the claims address the informalities raised by the Examiner in his objection to claims 1-8 and therefore the Applicant respectfully traverses this objection.

The Rejection under 35 U.S.C. § 102(e)

Claims 1, 3-5, 7 and 8 were rejected by the Examiner under 35 U.S.C. § 102(e) as being anticipated by Anderson et al. The Office Action states that the cited reference "teaches distinct stacking gel or other zones within the second dimension" and that these teaching "can be considered independent." The Examiner went on to reject claims 1-8 under 35 U.S.C. § 102(e) as being anticipated by Wiktorowicz et al. stating that the cited reference "discloses a method of two-dimensional separation using a second-dimension medium composed of a plurality of independent separation media" and that "plural channels can be considered independent." The Applicant will address both rejections simultaneously and respectfully traverses these rejections.

Although the Applicant does not acquiesce to these rejection, the newly presented claims are directed to the use of a plurality of capillaries provided on a planar support to achieve one dimension of separation of a test sample in a two-dimensional separation technique.

It is axiomatic that for a reference to anticipate a claim under Section 102, the reference must show each and every element or limitation of a claim. See *Hybritech v. Monoclonal Antibodies*, 231 U.S.P.Q. 81 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984) ("exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference").

Neither Anderson, et al. nor Wiktorowicz, et al., specifically teach a two dimensional separation technique whereby one of the dimension separations comprises a plurality of capillaries provided on a planar support. Consequently, neither Anderson, et al. nor Wiktorowicz, et al. cannot and do not anticipate the claimed invention. The Examiner admits that the reference do not teach each element as he himself adds the necessary elements by stating that pluralities and zones "can be considered independent" when this is in fact not taught by the references.

Therefore, since the plurality of capillaries provided on a planar support are disclosed by neither Anderson, et al. nor Wiktorowicz, et al., neither Anderson, et al. nor Wiktorowicz, et al. can anticipate the present invention.

The Rejection under 35 U.S.C. § 102(b)

Claims 1-8 were rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Ledley et al. The Office Action states that the cited reference "discloses a method

of two-dimensional separation using a second-dimension medium composed of a plurality of independent separation media." and that "plural channels can be considered independent." The Applicant respectfully traverses this rejection.

Again, as discussed above it is axiomatic that for a reference to anticipate a claim under Section 102, the reference must show each and every element or limitation of a claim and Ledely does not disclose the use of a plurality of capillaries provided on a planar support and thus cannot anticipate the present invention.

CONCLUSION

In view of the foregoing, the Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



Steven C. Petersen
Reg. No. 36,238

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 858-350-6100
Fax: 415-576-0300
Attachments
SCP:cag
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